



1632 #13
Dmt
4-16-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Beachy et al.

Serial No: 09/943,641

Filed: August 30, 2001

For: IDENTIFICATION OF ACTIVATED
RECEPTORS AND ION
CHANNELS

Attorney Docket No. JHUC-P01-017

Art Unit:

1632 1646

Examiner: BASI, Nirmal Singh

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

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Joanne Ryan

Commissioner of Patents
Washington, D.C. 20231

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REPLY TO RESTRICTION REQUIREMENT

TECH CENTER 1600/2900

Sir:

In reply to the outstanding Restriction Requirement regarding species election, mailed February 25, 2003, in connection with the above application, Applicants hereby elect, *for search purpose only*, species "G-Protein Coupled receptor (GPCR)" of Group I (claims 1-32), with traverse.

Applicants elect this species with traverse, because the subject matter of the elected species is closely related to other non-elected species – they are all members of the multi-pass transmembrane receptor, and can be searched simultaneously with the same generic terms such as "membrane receptor," transmembrane receptor," etc. Thus, simultaneous search of all elected and non-elected species would not constitute undue burden on the Examiner.

Currently, claims 1, 4, 5, 8-32 read on the elected species.

Applicants submit that species subjected to election are encompassed by a Markush group (in claim 5). Pursuant to MPEP 803.02, "If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions." Applicants submit that such is the case in the instant application. In addition, Applicants respectfully point out that the search of the Markush-type claim will be extended to non-elected species should no prior art be found that anticipates or renders obvious the elected species (MPEP 803.02).

Furthermore, Applicants note that claim 1 is a generic claim linking elected and non-elected species. Claims 2-4, 6, and 7 are dependent claims of claim 1 including all limitations of the generic claim 1. Pursuant to MPEP 809.04, "[i]f a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he or she must examine the claims to the non-elected inventions that are linked to the elected invention by such allowed linking claim." Thus, restrictions imposed on species encompassed by generic claims must be withdrawn upon indication of an allowable generic claim (MPEP 809). In other words, upon the allowance of a generic claim, Applicants are entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141 (MPEP 809.02(a)).

In addition, the burden is on the Examiner to examine these generic claims throughout their scope, together with any claims dependent thereon drawn to non-elected species or inventions, rather than for Applicants to limit the scope of the generic claims to conform to the scope of any species or inventions listed in a Restriction Requirement.

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition therefor and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**.

Respectfully Submitted,

Date: March 25, 2003

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